

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/565,478	Applicant(s) TOMALIA ET AL.
Examiner Elizabeth Robinson	Art Unit 1787

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 12, 13, 27, 32 and 37-39.
Claim(s) withdrawn from consideration: 1-9, 14-26, 28-31 and 33-36.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See attached PTO-892.

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787

/E. R./
Elizabeth Robinson
Examiner, Art Unit 1787

Continuation of 3. NOTE: The amendments to independent claim 12 add new limitations, not previously claimed, that would require further consideration and search. The nanoparticles must now be attached to the dendrons though the focal point of the dendron. Further, the attached groups must now not quench the photoluminescence of the composition. These limitations were not previously claimed.

Continuation of 11. does NOT place the application in condition for allowance because:

Regarding the 35 U.S.C. 112, first paragraph rejection of record, it appears that the cited section of the specification (using the article 34 specification amendment) supports the previously filed claim limitation. Thus, the 35 U.S.C., 112 first paragraph rejections of record are withdrawn. However, it is noted that if the claim amendments were entered, there would be a new 35 U.S.C., 112 first paragraph rejection over the limitation that the photoluminescence of the composition is not quenched. It appears that the component that has photoluminescence is the nanoparticle, not the composition.

Applicant argues that since the materials used to form the nanoparticle can form quantum dots and that quantum dots have photoluminescence, that the nanoparticles will have photoluminescence. However, the particles are claimed as nanoparticles, not as quantum dots and thus, can be of a larger size and not necessarily have photoluminescent properties.

The arguments regarding Vossmeier et al. (US 2003/0109056) are primarily directed to the claim amendment regarding the attach point of the nanoparticle. The claim amendments are not entered.

Further, regarding the Vossmeier reference, Applicant argues that tetrachloroethylene has an odor, not a fragrance. However, as evidenced by the Perchloroethylene fact sheet (Page 2), perchloroethylene is also called tetrachloroethylene and has a sweetish smell. This would fall under definition 2 of the definition of fragrance provided by Applicants.

Continuation of 13. Other: Attached is form PTO-892 to provide a reference to address Applicant's arguments regarding fragrance.